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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,383	09/30/2003	Harold Fisher	3589.68503	6841

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EXAMINER
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ROBINSON, JAMES MARSHALL

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3772

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10/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,383	<b>Applicant(s)</b> FISHER, HAROLD	
	<b>Examiner</b> James M. Robinson	<b>Art Unit</b> 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 31 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

### ***Response to Arguments***

Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive for the reasons discussed below. Note, applicant's Remarks (pg. 8, first whole paragraph), applicant disagrees with examiner's position that the claims (including specifically independent claims 16, 21, and 24) include functional language. Examiner still maintains that the claims recite structure defined by product by process language, which is functional language reciting no defining structure. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the

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same as a product of the prior art. For example, claim 16 recites "first loop being formed by folding said strap first end portion onto said strap intermediate portion..."

This recitation and all similar recitations in the claims are treated as a product-by-process limitation. Applicant has not claimed a method of forming a thumb splint, but rather applicant has claimed the thumb splint. Therefore, since the prior art meets the structural limitations (as noted below) or is capable of performing the function the rejection is necessitated.

### ***Claim Objections***

Applicant is requested to submit a new listing of claims. The listing of claims received 12/12/2005 is difficult to read and appears to differ from the claims reproduced in the applicant's Remarks because the underlining and "strikethrough" of amended claims is not clear.

Specifically, claim 16, line 17 recites --user's index finger; and a positioning--. It is noted that reproduced claim 16 in Remarks does not recite "and a positioning," however this is not the entered amended claims. A new listing of claims that clearly lines out deleted claim language and underlines amended claim language is necessary.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-17 and 19-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Starrett et al. (U. S. Patent No. 3,888,482). Starrett discloses a thumb splint comprising a first loop (19) wherein a loop attachment accommodates a user's thumb and a second loop (20) having a loop attachment to accommodate a user's index finger (Figs. 2-5). The first loop attachment is located outside of the second loop. Starrett further discloses a strap (22) having sufficient length to diagonally cross a user's palm (Figs. 2, 3, and 5).

Claims 16-18, 20, 21, 27, 30, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Lanz (AT No. 401,868). Regarding claims 16 and 21, Lanz discloses a thumb splint for limiting angular motion of a thumb, formed from a single elongate strap of non-elastic material having a first surface and a second surface, said thumb splint comprising: a first loop (1) formed at a first end of said strap, by folding said end of strap onto said strap, parallel thereto, and affixing said end thereto, said first loop being dimensioned to accommodate a user's thumb, near the base thereof; a second loop (2) formed in said strap a predetermined distance from said first loop, by folding said strap substantially transversely over and onto itself and affixing said strap to itself at the point of intersection, said second loop being dimensioned to accommodate a user's index finger; and a positioning means (Figs. 2-3) between said first loop and said second loop to hold said first loop near the base of said user's thumb and said second loop to said user's index finger.

Regarding claim 17, Lanz discloses in Figs. 2-3 wherein said positioning

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means comprises an elongate portion of said strap extending from said second loop, of a length sufficient to diagonally cross a user's palm and wrap around a user's wrist.

Regarding claim 18, Lanz also discloses wherein said thumb splint is worn in conjunction with a glove, and said positioning component comprises webbing of said glove, wherein said webbing is located between a thumb and finger receiving portion of said glove (Lanz, page 4 and claim 7).

Regarding claims 20, 23, Lanz discloses wherein said thumb splint prevents said thumb moving away from said index finger beyond 100° to a position where a wearer could injure the thumb (Lanz, page 1).

Claims 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Furr (U. S. Patent No. 5,188,356). Furr discloses a device comprising a thumb stabilizing component (Fig. 6), an index finger receiving section (31), a non-extendable flexible connector extending between the thumb section and index finger, an elongated strap formed from a single strip of webbing extending over a palm, wrist and back of a hand (Figs. 5-7) and velcro strips affixed to the elongated strap.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 22, 25 and 28-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanz in view of Furr. As discussed above, Lanz discloses the claimed but fails to teach the specific materials recited and specifically teach the band of material is provided with releasable securing means to secure the band of material around a person's wrist. However, Furr, which also relates to a thumb splint, teaches that it is known to releasably secure the band about the user's wrist. Thus, it would have been obvious to one skilled in the art at the time of the invention to incorporate the releasable securing means of Furr into the thumb splint of Lanz in order to facilitate the ease of removing the splint. Furthermore, the choice of material is considered a matter of obvious design choice within the knowledge of the skilled artisan as one with ordinary skill in the art would select a material based upon its suitability for the intended use.

Claims 18 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starrett in view of Lanz. As discussed above, Starrett discloses the claimed but fails to teach a thumb splint in combination with a glove or mitt. However, Lanz, which also relates to a thumb splint or sporting equipment device, teaches that it is known to include incorporate such a device into a glove or mitt. Thus, it would have been obvious to one skilled in the art at the time of the invention to incorporate the glove or mitt of Lanz into to the device of preventing injury during sporting activities.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24 and 25 are rejected on the ground of nonstatutory double patenting over claim1-2 of U. S. Patent No. 6,783,507 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of



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the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Robinson whose telephone number is (571) 270-3867. The examiner can normally be reached on Mon-Fri 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James M. Robinson/

/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772